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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sierra Entertainment, Inc.

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Serial No. 78101548

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Rod A. Rigole of Vivendi Universal Games, Inc. for Sierra Entertainment, Inc.

Tarah K. Hardy Ludlow, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

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Before Simms, Seeherman and Rogers, Administrative Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sierra Entertainment, Inc. has appealed from the final refusal of the Trademark Examining Attorney to register SPECIAL FORCES as a trademark for "computer game software and instruction manuals sold therewith."[1] Registration has been refused pursuant to Section 2(e)(1) of the Trademark

[1] Application Serial No. 78101548, filed January 8, 2002, and asserting a bona fide intent to use the mark in commerce.

Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified goods.

The appeal has been fully briefed. Applicant did not request an oral hearing.

It is the Examining Attorney's position that the mark describes a feature of the software, namely, the subject matter of the game. In support of this position, the Examining Attorney has provided a definition of "special forces": "a division of the U.S. Army composed of soldiers specially trained in guerrilla fighting."[2]

In its appeal brief, applicant points out that there is no evidence to indicate that the game must consist of army soldiers trained in guerrilla fighting, since its application is based on an intent to use the mark, and thus there are no specimens showing the mark as actually used. Apparently the Examining Attorney found that the broad identification of goods provided by applicant, without any limitation as to the type of computer game, was acceptable. This broad identification is, as the Examining Attorney points out, broad enough to include computer games of all types, including combat games simulating activities of the U.S. Army special forces. Moreover, applicant has not

[2] The American Heritage Dictionary of the English Language, 3d ed. © 1992.

denied that the U.S. Army special forces are a feature of its computer game.[3] Applicant's arguments against the mere descriptiveness of its mark actually support the view that its game does feature the Army special forces, since these arguments do not assert that the subject matter of the game is not the special forces. Rather, applicant contends that the mark is not merely descriptive because it does not describe all the details of the game, or it argues that imagination would be required to understand the subject matter of the game. See, for example:

> If one considers the various parameters extant in a software game of the complexity of SPECIAL FORCES, the retail consumer would not make the immediate connection that the SPECIAL FORCES mark completely describes the details of the game offered by the applicant. It can also be argued that the term SPECIAL FORCES alone does not adequately describe the game produced by the applicant because the mark does not contain the complete description of how the game is played and under what conditions.

Response filed October 16, 2002.

A mark is merely descriptive if it immediately conveys knowledge of the ingredients, qualities or characteristics of the goods with which it is used. In re Gyulay, 820 F.2d

[3] Presumably, if applicant did deny that the game was about or involved characters in the U.S. Army special forces, it would have faced a refusal on the ground that the mark is deceptively misdescriptive.

1216, 3 USPQ2d 1009 (Fed. Cir. 1987). It does not have to describe every quality, characteristic, function, attribute or feature of a product or service. It is sufficient if it describes a single, significant quality, feature, function, etc. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985).

Thus, the fact that the mark SPECIAL FORCES does not constitute the complete description of how the game is played and under what conditions is of no moment. It is sufficient that purchasers seeing the mark in connection with the goods, computer game software and instruction manuals sold therewith, would immediately understand that a feature of the game is that its subject matter relates to the U.S. Army's special forces. The mark SPECIAL FORCES directly conveys this information, without the need for any exercise of imagination on the part of the consumer.

In reaching this conclusion, we have considered applicant's argument that its mark "may suggest a connection to alien beings, witchcraft, the occult or supernatural phenomena" or to "a task force of police officers, fire fighters, rescue workers or any other agency that may delegate an exclusive group of people with exceptional or unusual skills to perform distinctive tasks." Brief, p. 3. Applicant apparently bases these

assertions on the dictionary definitions for "forces."[4] However, the mark is not "forces," but SPECIAL FORCES, and there is a clear meaning for this term as a whole. As a result, consumers are not likely to break down the mark into one of the meanings of "forces," then combine each or all of those definitions with the word "special" to arrive at the connotations that applicant suggests. Rather, they will view the mark SPECIAL FORCES as a reference to the U.S. Army division, and understand that this mark, when applied to applicant's computer game, describes a feature of the game.

It should also be noted that the situation presented here is distinguishable from the double entendre cases which applicant has cited. In cases such as In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE) and Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961) (POLY PITCHER), the marks, in addition to their descriptive meaning, had a non-descriptive meaning, i.e., a nursery rhyme and a Revolutionary War figure. Here, SPECIAL FORCES

[4] "1. Strength or energy exerted or brought to bear. 2. Moral or mental strength. 3. The capacity to persuade or convince. 4. Military strength. 5. A body of persons or things available for a particular end. 5. Any of the natural influences (gravity, electromagnetism) that exist between particles and determine the structure of the universe." Merriam-Webster's Collegiate Dictionary, 10th ed.

has only the meaning of U.S. Army fighters, and this meaning is descriptive of a feature of applicant's identified goods.

Applicant also asserts that its mark "does not fall into the same class of marks such as SCREENWIPE or BREADSPRED as Applicant's mark is not SPECIAL FORCES MILITARY FIGHTING GAME," reply brief, p. 5, and that "the words 'computer', 'game', or 'software' do not even appear in Applicant's mark." Reply brief, p. 6. Applicant is correct that its mark is not generic. However, genericness is not the basis for the refusal of applicant's application. It is not necessary that the type of goods be mentioned in applicant's mark for the mark to be found merely descriptive.

Finally, applicant has pointed to registrations for other marks which were found registrable without proof of acquired distinctiveness. Specifically, it claims that it owns a registration for SWAT, and that there are third-party registrations for such marks as BIG MUTHA TRUCKERS, COMMANDOS: BEHIND ENEMY LINES, FEAR EFFECT and GANGSTERS: ORGANIZED CRIME.[5] Aside from the fact that these marks are

[5] Applicant simply listed the marks, registration numbers and dates in its response to the first Office action. Such a listing is ordinarily not sufficient to make the registrations of record. See In re Duofold Inc., 184 USPQ 638 (TTAB 1974). However, the Examining Attorney did not object to the registrations, and in

different from the one at issue in this appeal, even if some prior registrations had some similar characteristics to applicant's mark, the Office's allowance of such prior registrations does not bind the Board. In re Nett Designs Inc., 236 F3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

Decision: The refusal of registration is affirmed.

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fact referred to them in the following (final) Office action. Therefore, we deem any objection to such registrations to be waived. See TBMP §1208.02 (2d ed. rev. 2004). Thus, we have considered the list of registrations. Applicant has also referred to additional registrations in its reply brief. Because these registrations were not made of record during the prosecution of the application, and have first been mentioned at a point that the Examining Attorney has had no opportunity to comment on them, they have not been considered. See Trademark Rule 2.142(d). We would add that even if these registrations were properly of record, they would not change the result in this case.